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No. 01-

IN THE

Supreme Court of the United States

SYMANTEC CORPORATION,

Petitioner,

v.

HILGRAEVE CORPORATION,

Respondent.

ON PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

PETITION FOR A WRIT OF CERTIORARI

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QUESTIONS PRESENTED

1. Whether the Federal Circuit, in the guise of claim construction, can usurp the constitutional and statutory functions of the Executive branch by amending the claims of an issued patent, rather than having the claims of an issued patent amended through the statutory scheme of reissue or reexamination?

2. Whether the Federal Circuit is misconstruing the fundamental principles of claim construction set forth by this Court in *Markman II* by failing to rely on the patent document as a whole and by instead basing its claim construction on an agreement of parties in a prior case?

3. Whether a court's patent claim interpretation has *stare decisis* effect and, if so, under what circumstances?

4. What deference must the Federal Circuit give to a district court's findings of fact relating to claim construction?

PARTIES TO THE PROCEEDING

The names of all parties in the court whose judgment is sought to be reviewed appear in the caption of this Petition for Writ of Certiorari. Petitioner Symantec Corporation has no parent corporations, and to Symantec's knowledge, no publicly held company owns 10% or more of Symantec stock.

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Appendix C — Order Of The United States Court Of Appeals For The Federal Circuit Denying Petition For Rehearing Dated And Filed November 6, 2001 ..... 46a

Petitioner Symantec Corporation ("Symantec") respectfully requests that a writ of certiorari be issued to review the judgment of the United States Court of Appeals for the Federal Circuit ("Federal Circuit") in this case.

OPINIONS BELOW

The Federal Circuit's decision vacating-in-part and affirming-in-part the District Court's order and remanding the case for further proceedings is reported at *Hilgraeve Corp. v. Symantec Corp.*, 265 F.3d 1336 (Fed. Cir. 2001). The corresponding judgment of the Federal Circuit vacating-in-part and affirming-in-part the District Court's order and remanding the case is not reported. The order of the Federal Circuit denying Symantec's combined Petition for Rehearing and Rehearing En Banc is reported at *Hilgraeve Corp. v. Symantec Corp.*, 2001 U.S. App. LEXIS 26125 (Fed. Cir. 2001). The order of the District Court granting Symantec's motion for summary judgment of non-infringement is reported at *Hilgraeve Corp. v. Symantec Corp.*, 90 F. Supp. 2d 850 (E.D. Mich. 2000).

STATEMENT OF JURISDICTION

The judgment of the Federal Circuit was entered on November 6, 2001. The Federal Circuit denied a timely Petition for Rehearing and Rehearing En Banc on November 6, 2001. The jurisdiction of this Court is invoked under 28 U.S.C. § 1254(1).

CONSTITUTIONAL AND STATUTORY PROVISIONS INVOLVED

Article I, section 8, clause 8 of the Constitution provides:

> Congress shall have the power . . . to promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their Respective Writings and Discoveries.

Amendment 5 of the Constitution provides, in pertinent part:

> No person shall . . . be deprived of life, liberty or property, without due process of law . . .

35 U.S.C. § 1 provides, in pertinent part:

> (a) Establishment. The United States Patent and Trademark Office is established as an agency of the United States, within the Department of Commerce. In carrying out its functions, the United States Patent and Trademark Office shall be subject to the policy direction of the Secretary of Commerce, but otherwise shall retain responsibility for decisions regarding the management and administration of its operations and shall exercise independent control of its budget allocations and expenditures, personnel decisions and processes, procurements, and other administrative and management functions in accordance with this title and applicable provisions of law.

35 U.S.C. § 251 provides, in pertinent part:

> Whenever any patent is, through error without any deceptive intention, deemed wholly or partly inoperative or invalid, by reason of a defective specification or drawing, or by reason of the patentee claiming more or less than he had a right to claim in the patent, the Director shall, on the surrender of such patent and the payment of the fee required by law, reissue the patent for the invention disclosed in the original patent, and in accordance with a new and amended application, for the unexpired part of the term of the original patent. No new matter shall be introduced into the application for reissue . . . [n]o reissued patent shall be granted enlarging the

scope of the claims of the original patent unless applied for within two years from the grant of the original patent.

35 U.S.C. § 305 provides, in pertinent part:

> In any reexamination proceeding under this chapter, the patent owner will be permitted to propose any amendment to his patent and a new claim or claims thereto, in order to distinguish the invention as claimed from the prior art cited under the provisions of section 301 of this title, or in response to a decision adverse to the patentability of a claim of a patent. No proposed amended or new claim enlarging the scope of a claim of the patent will be permitted in a reexamination proceeding under this chapter.

STATEMENT OF THE CASE

This case presents fundamental recurring legal questions stemming from the Federal Circuit's inconsistent treatment of patent claim interpretation issues under *Markman v. Westview Instruments, Inc.*, 517 U.S. 370 (1996) ("*Markman II*"), and the Federal Circuit's role as a court of first and last resort for patent litigants (subject to Supreme Court review). Specifically, the legal issues that arise from this case involve: (1) the extent to which the Federal Circuit may, in the guise of claim interpretation, usurp the authority granted by Congress to the U.S. Patent and Trademark Office to allow for amendment of claims of an issued patent through reissue or reexamination proceedings; (2) the Federal Circuit's failure to adhere to the basic guidelines set forth in *Markman II*, which provide that any claim interpretation will be based on the entire written document — without changing the essence of the patented invention — so that the relevant public will be on notice as to the metes and bounds of a patentee's rights; (3) the proper role of *stare decisis* as set forth in *Markman II* in arriving at a proper claim interpretation against a subsequent defendant not a party

to a prior litigation, particularly as in this case where the prior claim interpretation was based on an agreement between parties in the prior litigation; and (4) the deference, if any, that the Federal Circuit should give a district court's findings of fact relating to claim construction. The practice of amending claims in the guise of interpreting claims, along with the uncertain role of *stare decisis* in claim interpretation, lead to a result directly contrary to that intended in *Markman II* — uniformity, certainty and reasonable predictability as to the nature and scope of a patent.

A. United States Patent No. 5,319,776

The 5,319,776 (" '776") Patent, issued on June 7, 1994, relates to computer virus detection software. The software scans a data file for viruses as the file is being transferred to and before it is physically stored on a computer receiving the file. If the software detects a virus prior to storing the file, it automatically blocks storage of the file. The software may be used, for example, to scan a file for viruses as the file is being transferred from a floppy disk to a hard disk of a computer system, or as the file is being transferred from one computer system to the hard disk of another computer system.

Claim 1 of the '776 Patent is set forth below with the language at issue in italics[1]:

> 1. In a system for transferring digital data for storage in a computer storage medium, a method of screening the data as it is being transferred and automatically inhibiting the storage of screened data containing at least one predefined sequence, comprising the steps of:
>
> causing a quantity of digital data resident on a source storage medium to be

1. Claims 1 and 18 are the only independent claims that have been asserted against Symantec in this suit. Claim 18 is not reproduced here because it is similar to claim 1 for purposes of the issues presented here.

> transferred to a computer system having a destination storage medium;
>
> receiving and screening the transferred digital data prior to *storage* on the destination storage medium to determine if at least one of a plurality of predefined sequences are present in the digital data received; and
>
> in response to said screening step:
>
> (a) automatically causing the screened digital data to be stored on said destination storage medium if none of the plurality of predefined sequences are present, and
>
> (b) automatically inhibiting the screened digital data from being stored on said destination storage medium if at least one predefined sequence is present.

B. The Accused Products

Petitioner Symantec is a leading supplier of software for personal computers. Among Symantec's array of products is the pcANYWHERE™ line of products and the Norton AntiVirus™ line of products, both of which are able to detect the presence of computer viruses. Symantec's anti-virus products all require that any transfer of data be completed and that the transferred file be stored on the destination storage medium before testing for viruses. Hilgraeve is a computer software developer and owner of the '776 Patent.

C. The Proceedings Below

On September 15, 1997, Hilgraeve filed separate lawsuits for patent infringement against Symantec Corporation and McAfee Associates, Inc. ("McAfee"). Both lawsuits were filed

in the Eastern District of Michigan and concern the same patent (the '776 Patent). The actions were not consolidated and were assigned to different district court judges. The defendants in both cases moved for summary judgment of non-infringement. For various reasons, the McAfee case proceeded on a slightly faster track.

On June 10, 1999, the District Court in the McAfee case issued an opinion granting McAfee's motion for summary judgment of non-infringement. *Hilgraeve Corp. v. McAfee Assocs., Inc.*, 70 F. Supp. 2d 738 (E.D. Mich. 1999) ("*McAfee I*"). In that opinion, the McAfee court adopted the following interpretation of the claim term "storage": "storage occurs when the incoming digital data is sufficiently present on the destination storage medium, and accessible by the operating system or other programs, so that any viruses contained in the data can spread and infect the computer system." *Id.* at 745. The McAfee court did not perform its own analysis, but rather based its claim construction on an agreement between Hilgraeve and McAfee as to the meaning of the claim term "storage." *Id.*

Hilgraeve appealed the McAfee court's grant of summary judgment of non-infringement. The appeal related to the application of the claims to the accused products, but not to claim construction. Because of the uncertain precedential effect that the Hilgraeve appeal could have on Symantec, Symantec requested an opportunity to file an amicus brief regarding proper interpretation of the claims at issue in *McAfee I* — the same claims at issue in Symantec's case. The Federal Circuit denied Symantec's motion.

On August 2, 2000, the Federal Circuit vacated-in-part and affirmed-in-part the McAfee court's grant of summary judgment, and remanded the case for further proceedings. *Hilgraeve Corp. v. McAfee Assocs., Inc.*, 224 F.3d 1349 (Fed. Cir. 2000) ("*McAfee II*"). The Federal Circuit accepted, without further analysis, the district court's interpretation of "storage" because neither party

disputed claim construction on appeal, thereby setting the stage for the claim amendment and *stare decisis* issues set forth in this Petition. *Id.* at 1351.

On March 29, 2000, the District Court granted Symantec's motion for summary judgment of non-infringement. *Hilgraeve Corp. v. Symantec Corp.*, 90 F. Supp. 2d 850 (E.D. Mich. 2000) ("*Symantec I*"). In granting Symantec's motion, the court struggled with the preclusive effect of the earlier claim construction provided by the McAfee court. App. at 28a-29a, 34a-35a.[2] Ultimately, the Symantec court provided its own interpretation of the term "storage" which differed slightly from that of the McAfee court. App. at 35a-36a.

Hilgraeve appealed the infringement decision and Symantec cross-appealed as to the court's claim construction. The Federal Circuit vacated that part of *Symantec I* related to infringement and remanded. *Hilgraeve Corp. v. Symantec Corp.*, 265 F.3d 1336 (Fed. Cir. 2001) ("*Symantec II*"). In the opinion, the Federal Circuit rejected Symantec's proposed claim construction, and instead adopted a claim construction identical with that agreed to by Hilgraeve and McAfee in *McAfee I* (discussed more fully below). App. at 9a. It is apparent that the Federal Circuit, like the District Court in *Symantec I*, struggled with the precedential effect of a prior claim construction:

> We need not decide here whether our claim construction in McAfee II is binding on us in this case as a matter of stare decisis. Our decision in McAfee II was precedential, but it merely adopted the district court's claim construction in McAfee I based on the parties' agreement that the district court's claim construction was correct . . .

App. at 9a. These inconsistent statements reflect the Federal Circuit's struggle as to how it should properly treat its prior

2. Citations to the Appendix to this Petition are cited as App. at __a.

claim construction. On the one hand, the court states that it need not decide the *stare decisis* effect of its prior claim construction. Yet, on the other hand, the court states that its prior claim construction is precedential. Moreover, the Federal Circuit overturned the District Court's claim interpretation and adopted (and quoted) its earlier construction provided in *McAfee II*, which itself was based upon an agreement of Hilgraeve and McAfee. App. at 10a. From review of the opinion, it appears that the Federal Circuit must have felt bound, or at least constrained, by *stare decisis* to follow its prior claim construction, as did the District Court in *Symantec I*.

In "independently considering" the issues of claim construction, the Federal Circuit adopted the claim construction found in *McAfee II*, and cited as support one sentence out of context from the "Background and Summary" portion of the '776 Patent. App. at 9a-10a. The Federal Circuit virtually ignored the language of the claims, the patent specification, the disclosed embodiments, the prosecution history, and the testimony of Symantec's expert.

D. The Federal Circuit's Claim Construction

The Federal Circuit in *Symantec II* did more than merely interpret the claims of the '776 Patent. The Federal Circuit went beyond the scope of claim interpretation and changed the meaning of the claims to such an extent that the court effectively *amended* the claims. In order to understand the full flavor and effect of the Federal Circuit's claim interpretation, it is necessary to understand the patented technology and the related prior art.

Virus detection methods existed well before the '776 Patent. The '776 Patent describes a "major shortcoming" of such prior art as that it merely ". . . tests files which are already stored on the computer system's storage medium . . . ," but does not ". . . automatically prevent the virus from being stored on the medium in the first place. . . ." '776 Patent, column 1, lines 45-54. To overcome such shortcomings, the '776 patent discloses anti-

virus technology that receives a file as it is being transferred from a source computer and, prior to the file reaching the destination storage medium (hard disk), scans the file on a character by character basis to determine if the received file has a virus. Specifically, the '776 Patent discloses that

> [t]he present invention solves this problem by performing an in transit detection of computer viruses . . . [b]ecause the invention is able to test for viruses "on the fly," it is useful in data communication systems and in file copying systems to inhibit the virus from entering the computer in the first place.

'776 Patent, column 1, lines 55-63. As described in the '776 Patent, in-transit detection utilizes a filtering technique to match a pattern of characters in an incoming file (as it is being transferred) to detect the presence of a virus. '776 Patent, column 4, lines 11-22.

This interpretation of the '776 Patent is supported by the patent's prosecution history. During prosecution, Hilgraeve did two things in order to obtain the patent. First, it amended the claims as originally filed to specify that scanning occurs *prior* to storage on the destination storage medium in order to distinguish its claims over the prior art and to overcome the examiner's arguments. Lodging at L-1, L-2 (underlined amendments to claim 1). Second, Hilgraeve submitted a declaration of its president, and co-inventor of the '776 Patent, stating that the purpose of the invention was to prevent virus infection in the first place by entirely preventing the virus from reaching the destination storage medium. Lodging at L-9, ¶ 4. Thus, Hilgraeve expressly disclaimed an arrangement wherein the transferred file is stored on the destination storage medium before testing for viruses.

After the filing of the '776 Patent application, pattern matching during transfer was found insufficient by the anti-virus

industry. This was due to the fact that while filtering packages may readily detect conventional "first-generation" viruses (by searching for patterns), they are not suitable for detecting more advanced and sophisticated forms of viruses created by hackers, such as viruses that use self-modifying encryption.

Thus, the industry adopted a technology that differs from the '776 Patent. To detect these new self-modifying viruses, the next generation of anti-virus software, including the Symantec product, has to wait for the entire file (with the virus) to be received and stored on the destination storage medium. The new anti-virus software then reads the file from the storage medium, and randomly examines and executes different parts of the file to detect if a virus is present.

In the proceedings below, Symantec argued, based upon the patent document and the prosecution history, that the claim term "storage" be interpreted as occurring when the data become physically present on the destination storage medium. App. at 9a. The Federal Circuit in *Symantec II* adopted instead an interpretation of "storage" that fundamentally changes the essence of the '776 Patent. With the Federal Circuit's claim interpretation, which is the interpretation agreed upon by the parties in the McAfee case, the claims now allow for the virus to reach and be stored on the destination storage medium. Specifically, Claim 1 is now modified using the Federal Circuit's claim construction to read as follows:

> 1. In a system for transferring digital data for storage in a computer storage medium, a method of screening the data as it is being transferred and automatically inhibiting the storage of screened data containing at least one predefined sequence, comprising the steps of:
>
> causing a quantity of digital data resident on a source storage medium to be transferred to a compute system having a destination storage medium;

receiving and screening the transferred digital data prior to ~~storage on the destination storage medium~~ when the incoming digital data is sufficiently present on the destination storage medium, and accessible by the operating system or other programs, so that any viruses contained in the data can spread and infect the computer system to determine if at least one of a plurality of predefined sequences are present in the digital data received; and

in response to said screening step:

(a) automatically causing the screened digital data to be stored on said destination storage medium if none of the plurality of predefined sequences are present, and

(b) automatically inhibiting the screened digital data from being stored on said destination storage medium if at least one predefined sequence is present.

Such a claim construction improperly focuses the infringement analysis on the virus reaching and being stored on the destination storage medium, and broadens the claims so that it now allows for the virus to reach the hard disk. This is substantially different than the '776 Patent, which discloses that the best way to prevent harm from viruses is to not allow the virus to reach the storage medium in the first place. '776 Patent, column 1, lines 55-63. Moreover, by broadening the claims in this manner — beyond what is disclosed in the patent — the anti-virus industry has not been provided with notice of the scope of the claims.

REASONS FOR GRANTING THE WRIT

Claim construction determinations are pivotal to patent litigation because they shape the validity and infringement arguments that a party can make. With respect to infringement, claim construction is the first step in any patent infringement analysis. In *Markman I*, the Federal Circuit held *en banc* that "the interpretation and construction of patent claims, which define the scope of the patentee's rights under the patent, is a matter of law exclusively for the court." *Markman v. Westview Instruments, Inc.*, 52 F.3d 967, 970 (Fed. Cir. 1995). In *Markman II*, this Court affirmed the holding of the Federal Circuit because of the relative interpretive skills of judges and juries, and the need for national uniformity in the treatment of a given patent. This Court explained:

> The construction of written instruments is one of those things that judges often do and are likely to do better than jurors unburdened by training in exegesis. Patent construction in particular "is a special occupation, requiring, like all others, special training and practice. The judge, from his training and discipline, is more likely to give a proper interpretation to such instruments than a jury; and he is, therefore, more likely to be right, in performing such a duty, than a jury can be expected to be."

Markman II, 517 U.S. at 388-389 (internal citations omitted).

This Court in *Markman II* recognized that there are factual underpinnings of claim construction[3], and that such factual underpinnings are to be considered by the court as part of the claim construction process. Yet, the Federal Circuit has opined, contrary to *Markman II*, that "[n]othing in the Supreme Court's

3. *See Markman II*, 517 U.S. at 378 (calling the construction of a term of art following receipt of evidence a "mongrel practice"); *Id.* at 388 (suggesting that claim interpretation "falls somewhere between a pristine legal standard and a simple historical fact.")

opinion supports the view that the Court endorsed a silent, third option — that claim construction may involve subsidiary or underlying questions of fact." *Cybor Corp. v. FAS Techs.*, 138 F.3d 1448, 1455 (Fed. Cir. 1998) (en banc); *see also id.* at n.6 ("If this were so, surely the Supreme Court would have discussed whether subsidiary or underlying fact questions should be decided by the judge or the jury"). As a result, the Federal Circuit declared that it reviews a district court's findings regarding claim construction without deference "including any allegedly fact-based questions" that are presented. *Id.* at 1456.

In affirming the Federal Circuit, the Court in *Markman II* outlined a two-step process for determining whether infringement exists: first, the claims are construed, which is a task for the court; and second, the properly construed claims are compared with the accused device to see whether the device falls within the scope of the claims, which is a task for the jury. Since *Markman*, the courts, including the Federal Circuit, have struggled to determine how, when, and in what form claim interpretation issues should be decided. This struggle is most evident in the post-*Markman* reversal rate by the Federal Circuit of district courts' claim interpretations. A review of post-*Markman* Federal Circuit opinions has found a rate of reversal on claim construction issues of 29.6%. Christian A. Chu, *Empirical Analysis of the Federal Circuit's Claim Construction Trends*, 16 BERKELEY TECH. L.J. 1075, 1104 (2001). This figure suggests that *Markman* has not achieved the desired result of providing uniformity and predictability in patent infringement suits.

Markman has also created uncertainty regarding the proper application of *stare decisis* to issues of claim interpretation, and the proper scope of appellate review of a district court's claim interpretation. This uncertainty has led the Federal Circuit to reverse its own earlier claim interpretation in subsequent litigation involving a different defendant. *See, e.g., CVI/Beta Ventures, Inc. v. Tura LP*, 112 F.3d 1146 (Fed. Cir. 1997). It has

also led the Federal Circuit to adopt a claim interpretation different than that advanced by the parties, their experts, or that adopted by the district court, and to enter a judgment on appeal based on that claim interpretation without remand to the district court. *See, e.g., Exxon Chem. Patents v. Lubrizol Corp.*, 77 F.3d 450, 451 (Fed. Cir. 1996); *J.T. Eaton & Co. v. Atlantic Paste & Glue Co.*, 106 F.3d 1563, 1576-77 (Fed. Cir. 1997).

This disarray created in the wake of *Markman* makes it clear that the Federal Circuit needs further guidance in the area of claim construction. This need is no better exemplified than in this case, wherein the Federal Circuit misapplied and misunderstood the principles of claim construction set forth in *Markman* and, in the process, created several questions necessitating resolution.

A. Courts Are Not the Proper Forum for Amending Claims of an Issued Patent

The Federal Circuit, in usurping the functions of the Patent and Trademark Office (PTO) by amending the claims of the '776 Patent, has violated separation of powers principles by distorting the framework established by Congress. The Federal Circuit has also undermined the PTO's reexamination procedure by broadening the claims, and the PTO's reissue procedure by broadening the claims more than two years after issue.

The Constitution empowers Congress "[t]o promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their Respective Writings and Discoveries." U.S. Const. Art. I, § 8, cl. 8. Congress in turn has provided that "[w]hoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor." 35 U.S.C. § 101. To administer the patent system, Congress has established the PTO, which operates under the direction of the Secretary of Commerce and the Commissioner of Patents and Trademarks. *See* 35 U.S.C. §§ 1, 6, 131.

An inventor who seeks to patent an invention must file with the PTO an application containing a "specification," which sets out "a written description of the invention . . . in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains . . . to make and use the same." 35 U.S.C. §§ 111(a)(2), 112. The PTO then refers the application to a patent examiner assigned to an "art unit" that specializes in matters involving the particular technology described in the application. *See* U.S. Dep't of Commerce, Patent & Trademark Office, Manual of Patent Examining Procedure (MPEP) § 903.08(a) (7th ed., rev. Feb. 2000). It is the examiner's job to determine, in the first instance, whether the claimed invention is properly described in the specification and meets all of the requirements for patentability, including that there be sufficient "differences between the subject matter sought to be patented and the prior art . . . [and] that the subject matter as a whole would [not] have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains." 35 U.S.C. §§ 103(a), 131; *see also* 35 U.S.C. §§ 102, 112 (other requirements).

In addition to the statutory provisions regarding examination, the Congress has also established a framework for changing the claims of an issued patent. Claims of an issued patent can be changed through either a reissue proceeding or a reexamination proceeding. A reissue must be filed within two years of issuance of the original patent if the owner seeks to broaden the original claims, or at any time during the life of the patent if the owner seeks claims that are narrower in scope, or of the same scope, as the original claims. 35 U.S.C. § 251. With a reexamination, original claims can be amended or new claims can be added, but these claims cannot be broader in scope than the original claims. 35 U.S.C. § 305.

In the case of the PTO, Congress has created a comprehensive statutory scheme for the submission of patent applications to a specialized executive agency, the examination,

reissue or reexamination of those applications by qualified personnel, and the administrative grant or denial of patents. The statute itself makes it clear that Congress intended to place the administration of the patent system in the hands of a specialized agency that possesses both "competent legal knowledge and scientific ability." *See* 35 U.S.C. §§ 7(a) (detailing requirements for the appointment of examiners-in-chief), 282 (presumption of validity attaches to a patent upon issue). This Court has recognized that this statutory scheme sets forth a specific allocation of power amongst players in the patent system. *See Dickinson v. Zurko*, 527 U.S. 150 (1999) (the Federal Circuit should apply the standard of review set forth in the Administrative Procedure Act (APA) to review of the Patent and Trademark Office's findings of fact).

Not only do the actions of the Federal Circuit raise serious separation of powers issues, they also have very practical consequences that impair the objectives of the patent system. First, by amending claims of an issued patent, the Federal Circuit has undermined the public notice function of patent claims. The patent laws require a patentee to draft patent claims in a precise manner in order to provide notice to the public of the exact scope of the legal protection provided by the patent. This notice requirement is codified in the second paragraph of 35 U.S.C. § 112, which requires that the "specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention." The purpose of the notice requirement is to allow the public to know what it can and cannot do so that both the public and the inventors may benefit from the patent laws. For example, in *Universal Oil Products Co. v. Globe Oil and Refining Co.*, 322 U.S. 471, 484 (1944), this Court stated that:

> As a reward for inventions and to encourage their disclosure, the United States offers a seventeen year monopoly to an inventor who refrains from keeping his invention a trade secret. But the quid pro quo is

> disclosure of a process or device in sufficient detail to enable one skilled in the art to practice the invention once the period of the monopoly has expired; and the same precision of disclosure is likewise essential to warn the industry concerned of the precise scope of the monopoly asserted.

The limits of the patent must be known "for the protection of the patentee, the encouragement of the inventive genius of others and the assurance that the subject of the patent will be dedicated ultimately to the public." *General Elec. Co. v. Wabash Appliance Corp.*, 304 U.S. 364, 369 (1938). Otherwise, a

> zone of uncertainty which enterprise and experimentation may enter only at the risk of infringement claims would discourage invention only a little less than unequivocal foreclosure of the field,

United Carbon v. Binney & Smith Co., 317 U.S. 228, 236 (1942), and "[t]he public [would] be deprived of rights supposed to belong to it, without being clearly told what it is that limits these rights." *Merrill v. Yeomans*, 94 U.S. 568, 573 (1877) (cited and quoted in *Markman II*). The notice requirements discussed above are violated if the Federal Circuit can amend the claim of an issued patent by providing a claim interpretation not found in the public record, *i.e.* the claim language, the patent specification and the prosecution history.

Second, if the Federal Circuit can amend a claim by setting forth a certain claim interpretation, a patentee is able to avoid any negative consequences that may result from amending the claim during prosecution. For example, it is well-settled that there is a limitation on the doctrine of equivalents known as "prosecution history estoppel," whereby a surrender of subject matter during prosecution through claim amendment may preclude recapturing any part of that subject matter, even if it is equivalent to the matter expressly claimed. *See Warner-*

Jenkinson Co. v. Hilton Davis Chem. Co., 520 U.S. 17, 40-41 (1997); *see also Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 187 F.3d 1381 (Fed. Cir. 1999). This potential avoidance of prosecution history estoppel is exemplified in the case below. The Federal Circuit's claim interpretation returned to Hilgraeve subject matter that it expressly disclaimed during prosecution.

Third, proper administration of the patent system plays an important role in the continuing technological and economic development of the Nation. Congress, in creating the PTO, recognized the need for a specialized agency to examine patent applications and claim amendments in light of the prior art. Patents with claims that cover the prior art defeat the objectives of the patent system, and instead work to retard the "Progress of Science and useful Arts" and stifle technological and economic competition. The proper administration of the patent system would be disrupted if the Federal Circuit were permitted to amend or broaden claims in the guise of claim construction, as patentees would be able to come away from the courts with claims that cover the prior art.

B. The Decision Below Is Contrary to the Claim Interpretation Principles Set Forth in *Markman II*

In interpreting the claims of the '776 Patent, the Federal Circuit failed to adhere to the basic principles and guidelines set forth by this Court in *Markman II*. In *Markman II*, this Court held that the interpretation of patent claims is a question of law to be determined by the court rather than a question of fact to be decided by the jury. *Markman II*, 517 U.S. at 391. In making claim interpretation the exclusive province of the courts, this Court relied primarily on two functional considerations — expertise in textual interpretation and the need for national uniformity — to hold that "judges, not juries, are better suited to find the acquired meaning of patent terms." *Id.* at 388. In considering the relative expertise of courts and juries, this

Court found that a "judge, from his training and discipline, is more likely to give a proper interpretation to such instruments than a jury." *Id.* at 389.

This Court's assumption that a court is better suited to interpret claims is based on certain fundamental principles and expectations. For example, this Court expected that in interpreting a claim, a court "proceeds upon its own responsibility, as an arbiter of the law, giving the patent its true and final character and force." *Id.* at 388. In doing so, a court is to seek out "the character of the thing invented." *Id.* at 386. A court is also expected to perform the "necessarily sophisticated analysis of the whole document, required by the standard construction rule that a term can be defined only in a way that comports with the instrument as a whole." *Id.* at 389. Further, a court in construing a claim term can be assisted by expert testimony that is "consistent with a patent's internal logic." *Id.*

This Court in *Markman II* also expected that allocating all issues of claim interpretation to the courts would provide uniformity in the treatment of a given patent, and thus provide the public with reasonable certainty regarding the scope of a patentee's rights. *Id.* at 390.

The Federal Circuit, in the case below, failed to adhere to these basic principles and guidelines in interpreting the claims of the '776 Patent. The Federal Circuit's claim interpretation was not based on the patent document as a whole and fundamentally changed the character of the invention. To support its claim construction, the Federal Circuit summarily cited one sentence from the "Background and Summary" portion of the '776 Patent, and virtually ignored the language of the claims, the patent specification, the disclosed embodiments, the prosecution history, and the testimony of Symantec's expert. Rather than interpreting the term "storage" in a manner that comports with the patent document as a whole, the Federal Circuit relied upon an out-of-context quotation of a single sentence discussing the prior art — not the claimed invention.

Further, the Federal Circuit adopted the construction provided in *McAfee II*, which itself was based upon an agreement of the parties. At no point has this Court, or even the Federal Circuit itself, stated that a private agreement between parties as to the meaning of a claim term is proper evidence to consider when construing claims. In fact, basing a claim construction on this type of extrinsic evidence belies the principle set forth in *Markman II* that a patent must give adequate notice to the public of the proposed claim construction. *See also Southwall Tech., Inc. v. Cardinal IG Co.*, 54 F.3d 1570, 1578 (Fed. Cir. 1995) ("A patentee may not proffer an interpretation for the purposes of litigation that would alter the indisputable public record consisting of the claims, the specification and the prosecution history, and treat the claims as a 'nose of wax.' ")

The Federal Circuit's clear divergence from the principles set forth in *Markman II* necessitate review by this Court. It has been observed that

> [a]s a result of the Federal Circuit's monopoly over substantive patent law adjudication, the consequences of systematic Supreme Court recusal from patent law are serious . . . [u]nlike other areas of its jurisprudence, Supreme Court silence in substantive patent law readily allows the Federal Circuit to anoint itself a de facto court of last resort in patents.

Mark D. Janis, *Patent Law in the Age of the Invisible Supreme Court*, 2001 U. ILL. L. REV. 387, 402 (2001).

C. The Application of Traditional *Stare Decisis* Principles is Problematic in the Area of Claim Construction

In the wake of *Markman II*, the Federal Circuit has struggled with the appropriate application of *stare decisis* to its own claim interpretations. *See, e.g., CVI/Beta Ventures*, 112 F.3d 1146 (the Federal Circuit reversed its own earlier claim interpretation

as a question of law in subsequent litigation with a different defendant.) As noted by one Federal Circuit judge:

> [I]f the Federal Circuit's reading of the very same claim can vary from one appeal to the next, every patent litigant has an incentive to appeal every action to the Federal Circuit in hopes that the statistics will hold up and eventually the appellate court will reverse. Even the Federal Circuit's claim interpretations as questions of law are not certain. Is this the "uniformity" outlined by the Supreme Court in Markman II?

Cybor Corp., 138 F.3d at 1477 (Rader, J., dissenting). This struggle is further reflected in the case below, wherein the Federal Circuit apparently felt bound to follow its prior claim construction in *McAfee II* (and wherein the district court in *Symantec I* felt bound by a prior claim construction of the district court in *McAfee I* — both district courts being in the Eastern District of Michigan).

The Federal Circuit's inconsistent application of *stare decisis* to claim construction issues stems from this Court's pronouncements in *Markman II*. This Court envisioned that *stare decisis* would operate in some fashion to provide uniformity in the treatment of a given patent when issue preclusion is unavailable, as where a patentee seeks to assert issue preclusion against a new and independent defendant:

> Uniformity would, however, be ill served by submitting issues of document construction to juries. Making them jury issues would not, to be sure, necessarily leave evidentiary questions of meaning wide open in every new court in which a patent might be litigated, for principles of issue preclusion would ordinarily foster uniformity. Cf. *Blonder-Tongue Laboratories, Inc. v. University of Ill. Foundation*, 402 U.S. 313, 28 L. Ed. 2d 788, 91 S. Ct. 1434

> (1971). But whereas issue preclusion could not be asserted against new and independent infringement defendants even within a given jurisdiction, treating interpretive issues as purely legal will promote (though it will not guarantee) intrajurisdictional certainty through the application of stare decisis on those questions not yet subject to interjurisdictional uniformity under the authority of the single appeals court.

Markman II, 517 U.S. at 391. However, this Court did not clarify how and to what extent *stare decisis* would operate to achieve the goal of providing uniformity in the treatment of a given patent.

The Federal Circuit's problem with defining the proper role of *stare decisis* in the area of claim construction is understandable. The unique nature of the claim construction process makes the application of traditional *stare decisis* principles problematic. While claim interpretation has been declared a question of law, the process also involves consideration of underlying facts. This Court itself recognized that claim construction is not a purely legal matter. *See, e.g.*, *Markman II*, 517 U.S. at 378 (calling the construction of a term of art following receipt of evidence a "mongrel practice:); *Id.* at 388 (suggesting that claim interpretation "falls somewhere between a pristine legal standard and a simple historical fact.") This factual element of claim interpretation is not easily reconcilable with the tenet that *stare decisis* does not apply to factual determinations or to mixed questions of law and fact. *See* 18 MOORE'S FEDERAL PRACTICE § 134.05[3] (3d ed. 2001).

Further, traditional principles of *stare decisis* provide that

> [a] decision of an appellate court constitutes a precedent only insofar as it determines some issue of law. For *stare decisis* to be applied, an issue of

> law must have been heard and decided. If an issue is not argued . . . the decision does not constitute a precedent to be followed in subsequent cases in which the same issue arises.

Id. at § 134.04[2]. "Issues that merely lurk in the record are not stare decisis." *Id.* at n.17. *See also Estate of Magnin v. Commissioner*, 184 F.3d 1074, 1077 (9th Cir. 1999) (when circuit court panel opinion assumes a particular point without discussion, it does not bind future panels on that point). With claim construction, often times not all claim elements are fully litigated, as in the case when parties agree as to a claim construction, as Hilgraeve and McAfee did in *McAfee I* and *II*.

It is also well-settled that courts are not bound by stipulations as to questions of law. *See Estate of Sanford v. Commissioner*, 308 U.S. 39, 51 (1939) ("We are not bound to accept, as controlling, stipulations as to questions of law."); *see also Technicon Instruments Corp. v. Alpkem Corp.*, 866 F.2d 417, 421-422 (Fed. Cir. 1989) ("If the stipulation is to be treated as an agreement concerning the legal effect of admitted facts, it is obviously inoperative; since the court cannot be controlled by agreement of counsel on a subsidiary question of law.") (*quoting Swift & Co. v. Hocking Valley Ry. Co.*, 243 U.S. 281, 289 (1917)). Hence, any claim construction based upon an agreement of the parties cannot possibly have precedential effect.

Another problem with applying traditional notions of *stare decisis* to claim construction is that each new defendant in a patent suit is entitled to make its own defense. As stated by this Court, estopping a defendant from providing a defense in a patent infringement suit violates due process:

> Some litigants — those who never appeared in a prior action — may not be collaterally estopped without litigating the issue. They have never had a chance to present their evidence and arguments on the claim. Due process prohibits estopping them

> despite one or more existing adjudications of the identical issue which stand squarely against their position.

Blonder-Tongue Lab. v. University of Illinois Found., 402 U.S. 313, 329 (1971). Matters of claim construction are a crucial part of any defense to a patent infringement suit. It has been recognized that "to decide what the claims mean is nearly always to decide the case." *Markman I*, 52 F.3d at 989 (Mayer, J. concurring). Hence, the same due process principles that disallow estoppel in an infringement suit should apply equally to disallow Symantec from being bound by a claim construction arrived at through an agreement of different parties in a prior lawsuit. Binding Symantec to such a claim construction, when the Federal Circuit denied Symantec's attempt to file an amicus brief and participate in the claim construction process, effectively strips Symantec of the right to provide its own defense — a right guaranteed by the due process clause.

The case below uniquely illustrates the problem with applying traditional *stare decisis* principles to issues of claim construction. The Federal Circuit effectively applied the doctrine of *stare decisis* to bind Symantec to a claim construction arrived at in a prior appeal (*McAfee II*), to which Symantec was not a party. This application of *stare decisis* is problematic for two reasons. First, the issue of claim construction was never fully litigated at either the trial court or appellate court level. The District Court in *McAfee I* did not perform its own claim construction based upon conflicting interpretations, but rather merely accepted an agreement of the parties as to meaning of the claim term "storage." On appeal, the Federal Circuit in *McAfee II* accepted without analysis the district court's claim interpretation because the issue of claim construction was not before the court. Second, the claim construction found in *McAfee II* could not be used as precedent because the claim construction was based upon an agreement of the parties. As stated above, a court cannot be controlled by agreement of parties

on a question of law. Permitting parties to contract to a legal conclusion emasculates the role of the courts in interpreting claims, and thus undermines the regime set forth in *Markman II*. The problems associated with the Federal Circuit's adherence to precedent in this case make it clear that this Court needs to address the question of the proper role of *stare decisis* in the area of claim construction.

D. Different Groups of Judges of the Federal Circuit Have Not Agreed on the Proper Role for Appellate Review of a District Court's Claim Construction

In the case below, the Federal Circuit indicated that claim construction requires an independent review, and the Federal Circuit did not grant any deference to — or even discuss — the findings of the District Court. App. at 10a. After this Court's decision in *Markman II*, it is clear that courts, not juries, are to construe patent claims. However, the judges of the Federal Circuit, in a fractured opinion, were not able to agree on what degree of deference must be shown a district court's findings. *See Cybor*, 138 F.3d 1448. The majority opinion in *Cybor* asserted that the district court is owed no deference on any findings relating to claim interpretation. *Id.* at 1456. The concurring and dissenting opinions asserted that *Markman II* stopped short of authorizing the Federal Circuit to find facts *de novo* when evidentiary disputes exist as part of the construction of a patent claim, and cited as support earlier Federal Circuit opinions, such as *Fromson v. Anitec Printing Plates, Inc.*, 132 F.3d 1437 (Fed. Cir. 1997); *Eastman Kodak Co. v. Goodyear Tire & Rubber Co.*, 114 F.3d 1547, 1555-56 (Fed. Cir. 1997); *Serrano v. Telular Corp.*, 111 F.3d 1578, 1586 (Fed. Cir. 1997) (Mayer, J., concurring); *Metaullics Sys. Co. v. Cooper*, 100 F.3d 938, 939 (Fed. Cir. 1996). *Id.* at 1462-1481 (concurring opinions, dissenting opinions, and additional views)

Claim interpretation involves weighing some facts. *See Multiform Desiccants, Inc. v. Medzam, Ltd.*, 133 F.3d 1473,

1477 (Fed. Cir. 1998) ("It is the person of ordinary skill in the field of the invention through whose eyes the claims are construed."). This Court's precedent is clear: a court of appeals may not independently review the facts and reverse a finding by a trial court "because it is convinced that it would have decided the case differently." *Anderson v. City of Bessmer City, N.C.*, 470 U.S. 564 (1985); *see also* Fed. R. Civ. P. 52(a) ("Findings of fact, whether based on oral or documentary evidence, shall not be set aside unless clearly erroneous . . .).

The center of the Federal Circuit's debate is the ruling of the Court in *Markman II.* In *Markman I*, the Federal Circuit reasoned that claim construction is a matter of law subject to plenary appellate review. This Court agreed with the Federal Circuit that the question of claim construction is to be decided by the judge, rather than the jury. However, this Court repeatedly intimated that claim construction is not a purely legal matter. *See, e.g., Markman II*, 517 U.S. at 378 (calling the construction of a term of art following receipt of evidence a "mongrel practice"); *Id.* at 388 (suggesting that claim interpretation "falls somewhere between a pristine legal standard and a simple historical fact" (quoting *Miller v. Fenton*, 474 U.S. 104, 114 (1985))); *Id.* at 390 ("notwithstanding [claim construction's] evidentiary underpinnings"). Moreover, this Court did not decide which standard of review would apply in appeals of patent infringement cases. *See generally Id.* at 376-91.

In the time since *Markman II*, the Federal Circuit has stated that it has the authority to "review the issue of claim interpretation independently without deference to the trial judge." *Exxon*, 64 F.3d at 1556. Indeed, the Federal Circuit has gone so far as to claim that the law allows "independent determination of the construction of the claims, as a matter of law, unencumbered by the trial process." *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 72 F.3d 857, 863 (Fed. Cir. 1995), *vacated and remanded on other grounds*, 117 S. Ct. 1240 (1997). Such views have been criticized, even within the Federal Circuit.

> If claim construction is only a question of law to be reviewed by [the Federal Circuit] *de novo*, then the absence of review as a matter of right over our claim constructions, which may be new and unsupported by legal analysis, or may never have been tested by the adversarial process, would transform [the Federal Circuit] into a trial court of first and usually last resort.

Cybor, 138 F.3d at 1466 (Mayer, C.J., concurring).

It is apparent that the Federal Circuit's *de novo* standard of review has led to a court that is more willing to disregard the lower tribunals' constructions in favor of its own interpretation, and in the case below, in favor of an uncritical acceptance of an agreement of other parties in a different case. Thus, the uniformity and predictability in the patent world envisioned in *Markman II* has been undermined by the actions of the Federal Circuit. The Federal Circuit is no longer acting as an appellate court, but rather as a trial court of first and last resort for patent litigants.

CONCLUSION

Accordingly, Symantec respectfully requests that its Petition for Writ of Certiorari be granted.

Respectfully submitted,

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